



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

VB

APPLICATION NO.	FILING DATE	CLASS	FIRST NAMED INVENTOR	J	ATTORNEY DOCKET NO.
09/165,460	10/02/99	RINE			

HM12/1222

REGINALD J. SUYAT
FISH & RICHARDSON
2200 SAND HILL ROAD
SUITE 100
MENLO PARK CA 94025

TUNG, P	EXAMINER
---------	----------

ART UNIT 1652	PAPER NUMBER
------------------	--------------

6
12/22/99

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/165,460

Applicant(s)
Rine et al.

Examiner
Peter Tung

Group Art Unit
1652



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-30 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a process of inhibiting Afc1p and Rce1p proteases, classified in class 424, subclass 94.64.
 - II. Claims 5-9, drawn to a process of testing for Afc1p and Rce1p protease inhibitors, classified in class 435, subclass 7.31.
 - III. Claims 10-13, 17-19, 22-24 and 26-28, drawn to vectors comprising DNA encoding Afc1p and Rce1p and transformed host cells, classified in class 435, subclass 219.
 - IV. Claims 15 and 29, drawn to Afc1p and Rce1p polypeptides, classified in class 435, subclass 219.
 - V. Claims 16, 20 and 21, drawn to anti- Afc1p and Rce1p antibodies, classified in class 530, subclass 387.1.
 - VI. Claims 20, 21 and 30 , drawn to an afce1p and rce1p DNA detection kit , classified in class 435, subclass 6.
 - VII. Claim 25, drawn to a cell comprising afc1 and/or rce1 deletions, classified in class 435, subclass 325.
2. The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1652

Each of Groups III, IV, V, VI and VII is directed to a separate and distinct invention. Group III is directed to vectors comprising DNA encoding Afc1p and Rce1p and transformed host cells, Group IV is directed toward Afc1p and Rce1p polypeptides, Group V is directed toward anti-Afc1p and Rce1p antibodies, Group VI is directed toward an afc1p and rce1p DNA detection kit and Group VII is directed toward a cell comprising afc1 and/or rce1 deletions.

The products of Group III, IV, V, VI and VII would be expected to have distinct morphological, functional, chemical and physical properties as indicated by their divergent classification, process of making and process of using. These products are capable of separate manufacture, use, or sale as claimed, and are patentably distinct.

The several inventions above are independent and distinct from each other. They have acquired a separate status in the art as a separate subject for invention and separate field of search, as indicated by the different classification.

3. Each of Groups I and II is directed to a separate and distinct invention. Group I is directed to a method of inhibiting Afc1p and Rce1p proteases and Group II is directed to a method of testing for Afc1p and Rce1p protease inhibitors. These methods are distinct both physically and functionally, require different process steps, reagents and parameters and produce different products.

Art Unit: 1652

4. Inventions of Group IV and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a different process such as producing antibodies against the protein.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. A telephone call was made to Mr. Reginald Suyatt on 9/20/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

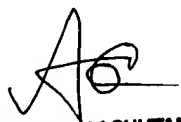
Art Unit: 1652

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Tung, Ph.D. whose telephone number is (703) 308-9436. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, Ph.D., can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600